

REMARKS/ARGUMENTS

The issues raised in the Office Action dated June 29, 2004 have been considered. Claims 1-40 and 51-59 are pending in the application. Claims 60-63 have been added. Reconsideration and allowance of the application is respectfully requested. Authorization is also hereby provided to charge/credit deposit account No. 50-0996 (NOKV.008PA) for any under/over payment in connection with the instant Office Action Response, including charges for excess claim fees in view of newly added claims 60-63.

Claims 56 and 57 stand rejected under 35 U.S.C. §112 as indefinite. Applicant has amended claims 56 and 57 to address the Examiner's concerns regarding clarity. As the amendment to claims 56 and 57 merely revises the phrasing of the limitations already present in the original claims, the amendments are for reasons not related to patentability. Moreover, the amendments to claims 56 and 57 do not have a narrowing effect. Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §112.

Claim 21 stands rejected under 35 U.S.C. §102(e) as being anticipated by *Morimoto* (U.S. Publication No. 2002/0013774). Claims 1-15, 22-27, 33-40, 51, and 52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Morimoto*. Claims 16-19 and 28-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Morimoto* in view of *Kojima* (U.S. Publication No. 2003/0078862). Claims 20 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Morimoto* in view of *Melchior* (U.S. Publication No. 2002/0107785). Claims 53-59 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Morimoto* in view of *Walker* (U.S. Patent No. 6,064,987).

Claim 21, and all other pending independent claims, recite a trusted server that facilitates a contractual transaction as between a merchant system and a buyer system. The trusted server operates as an impartial intermediary to facilitate preparation and execution of a contract between the merchant and buyer systems.

Morimoto, in contrast, discloses a system of negotiating improved terms for the purchaser of a transaction. *Morimoto* teaches a personal broker-agent program that disrupts a transaction between a seller and purchaser. The personal broker-agent program taught in *Morimoto* operates to improve the position of the purchaser, and can operate to terminate a

transaction between a seller and purchaser if more favorable terms can be obtained for the purchaser. A portion of the savings realized by the purchaser are retained by the personal broker-agent program as profit. If the purchaser opts not to enter into an agreement with the personal broker-agent program to attempt to obtain more favorable terms for the purchaser, the purchaser may execute the original transaction with the seller. *See, e.g.*, paragraphs [0011]-[0014].

Morimoto clearly fails to disclose a system that provides a trusted server as is recited in Applicant's claims. The personal broker-agent program of the *Morimoto* system operates, as the name implies, to improve the position of one party (*i.e.*, the purchaser) to the detriment of another party (*i.e.*, the seller) in a contract transaction.

Moreover, *Morimoto* fails to disclose a system that provides a trusted server that operates as an intermediary to facilitate preparation and execution of a contract between the merchant and buyer systems. The parties to the contract generated by *Morimoto* are the purchaser and the personal broker-agent program, not the purchaser and a seller. *Morimoto's* personal broker-agent program does not involve itself in the execution of the original transaction (*i.e.*, between a purchaser and an original seller) or execution of an alternative transaction (*i.e.*, between a purchaser and a new seller w/ improved terms for the buyer).

For at least these reasons, *Morimoto* fails to anticipate Applicant's claim 21.

To establish *prima facie* obviousness of a claimed invention, the Examiner has the burden of proving that three basic criteria are met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. All three of these criteria must be met in order to support a finding of *prima facie* obviousness of a claimed invention (*see, e.g.*, MPEP § 2142).

Moreover, it is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be "clear and particular." *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of references, standing alone, are not evidence. *Id.*

Morimoto, alone or in combination with the other references relied on by the Examiner, fails to teach or suggest all limitations recited in Applicant's rejected claims. As is discussed above, *Morimoto* wholly fails to teach or suggest a trusted server that facilitates a contractual transaction as between a merchant system and a buyer system. For at least this reason, *Morimoto*, alone or in combination with the other references relied on by the Examiner, fails to render Applicant's rejected claims obvious.

Moreover, the asserted references, alone or in combination, fail to provide the requisite motivation to support their combination in the manner advanced by the Examiner. The teachings of *Morimoto* discourage use of a trusted server, and would motivate one skilled in the art to employ a biased agent for the benefit of only one party to a contractual transaction. It is unclear how *Morimoto*, alone or in combination with other art references relied on by the Examiner, could provide the requisite motivation to combine the reference teachings in the manner suggested by the Examiner given the incongruous objectives of the *Morimoto* system relative to those of Applicant's claimed systems and methods. Moreover, *Morimoto*, alone or in combination with other art references relied on by the Examiner, fails to provide a reasonable expectation of success, given the considerations discussed above.

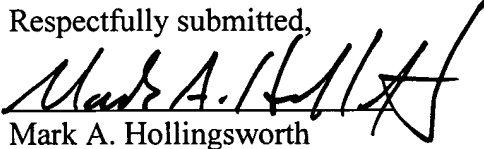
For at least these reasons, the asserted combination of *Morimoto*, alone or in combination with *Kojima*, *Melchior*, or *Walker*, fails to render Applicant's subject matter of claims 1-59 obvious. New claims 60-63 are patentable over the art of record for reasons set forth hereinabove.

Without acquiescing to the Examiner's characterization of the asserted references as they have been applied to Applicant's rejected dependent claims, Applicant believes it unnecessary to address the specific grounds for rejection in view of the clear grounds for patentability of the claims from which they respectively depend. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicant, however, reserves the right to address these rejections should the

Examiner maintain the rejection of the base claims, notwithstanding Applicant's remarks presented hereinabove.

It is believed that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if there are any questions regarding the above new claims or if prosecution of this application may be assisted thereby.

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